

reconsideration of the patentability of the present claims, as amended, is respectfully requested in view of the following comments.

The Prior Art

Wohead discloses a non-snagging fishing device for use as a sinker and includes a pair of plastic hollow sections 13 and 14 which are joined together by a coupling means 15. A weighted portion 23 is connected at the outer distal end of the hollow tubular section 14. The hollow tubular portion 14 is detachable from the coupling 15 and thus detachable from the upper hollow section 13 as well. The detachability of the hollow section 14 is important and in fact critical to the disclosure of Wohead because it permits additional weight elements such as the lead shot 28 to be added or removed from the hollow section 14 to change the sinking and floating characteristics of the device. The embodiment of Figure 4 is similar in that the tubular body 41 includes a detachable weight member 45 at its bottom end. To form a buoyant portion, a plug 46 is inserted into the tubular body in a position which is spaced from the weighted member 45. The space between the plug 46 and the detachable weight member 45 forms a further chamber for receiving additional weight elements such as the cylinders 49. In this embodiment, like the embodiment of Figure 3, both the weight element, as well as the element 49, are detachable from one another and from the device itself.

Witkoski discloses a combination bobber-sinker which includes an upper end comprising a bullet-shaped float 10 and a bottom portion comprising a removable, apertured weight-receiving chamber 12. The chamber 12 is selectively connectable to the float 10 and is designed to receive a plurality of weights 14 (Figures 1 and 2) to control the buoyancy of the bobber-sinker.

The Amendments to the Claims

Each of the independent claims 1 and 26 is directed to a fishing sinker having an elongated body with a line connection end, a free end and a weighted portion with a density greater than that of water. The sinker of claims 1 and 26 also includes a noise-generating element connected with the weighted section (claim 1) or elongated body (claim 26), with the noise-generating element comprising a hollow member and one or more noise-generating objects movable freely within the hollow member. Pursuant to the above amendments, the noise-generating element is required to be “non-detachably” connected with the weighted section (claim 1) or elongated body (claim 26). This limitation, in combination with the other limitations of independent claims 1 and 26, clearly distinguish independent claims 1 and 26, and thus, their respective dependent claims, from Wohead and Witkoski for the reasons set forth below.

Independent claim 26 has also been amended to provide antecedent basis for the term “weighted section” and thus the § 112 rejection has been overcome.

Differences Between The Amended Claims And The Cited References

In the Examiner’s rejection of independent claims 1 and 26 as being anticipated by Wohead, the Examiner’s position is that the plug means 15 is the “weighted section.” There is absolutely no basis for this conclusion. In fact, it is contrary to the teachings of that reference. In Wohead, the “weighted section” is disclosed as the weighted end 23 (Figure 3), or the weighted end 45 (Figure 4). Additionally, the lead shot 28 (Figure 3) and the lead cylinders 49 (Figure 4), are disclosed as being weighted members. There is simply no disclosure that the coupling 15 of Figure 3 or the plug 46 of Figure 4 are weighted members.

The Examiner's reasoning is that because the disclosure states that chamber 20 "is a buoyant portion of the device 10," then all of the remaining elements must be non-buoyant. This cannot be supported. By the same logic, because elements 23, 28, 45 and 49 are disclosed as "weighted portions," or "weighted materials," then all of the other portions of the device must be non-weighted or buoyant.

In contrast to the Examiner's position, it is at least equally likely, and most probably more likely, that the coupling 15 is constructed of a plastic of some sort which is buoyant. This would be consistent with the material from which the other elements of the device are constructed. Thus the coupling 15 of Wohead cannot be considered as the weighted section, and therefore, the limitations of claims 1 and 26 are simply not met because the weighted section is not between the noise generating element and the line connection end.

However, even if the coupling 15 is considered as the weighted section as the Examiner contends, the claims now require the noise-generating element to be "non-detachably" connected with the weighted section (claim 1), or the elongated body (claim 26). This limitation is clearly not met. Accordingly, independent claims 1 and 26, and their respective dependent claims, are distinguishable from Wohead under § 102.

Further, it would not have been obvious to modify Wohead by making the bottom section 14 non-detachable from the coupling 15. As indicated above, a critically important feature of the device of Wohead, and a feature upon which the patentability of Wohead is based, is the detachable bottom portion which can be detached for the purpose of adding or removing weights to vary the buoyancy of the device. If the bottom tube 14 was made "non-detachable" in order to

meet the claim language, the weights within the tube 14 could not be varied, thereby eliminating an important feature of Wohead.

The law is clear that the references themselves must provide a motivation for modifying a reference, and that any such modification of a reference must be consistent with the teachings of that reference. A modification of Wohead to make what the Examiner is considering as the noise-generating element non-detachable from the weighted element (the coupling 15) would be inconsistent with the teachings of Wohead and therefore not obvious.

Witkoski is distinguishable from independent claims 1 and 26, and thus their respective dependent claims, for similar reasons. The Examiner's position is that the member 32 is the "weighted section" because it is made of a sinking material, namely, metal because of the cross-hatching. While this may be true, the weighted section of Witkoski, as it is disclosed and as it would be construed by a person skilled in the art, is the "weight receiving chamber" 12, which is formed to receive a plurality of weights 14. Thus, contrary to the position of the Examiner, the disclosure of Witkoski does not consider the member 32 as the weighted element or weighted section.

However, regardless of whether the member 32 is considered to be the weighted section or not, the portion of Witkoski which the Examiner is considering as the noise-generating element, namely, the weight-receiving chamber 12, does not meet the "non-detachable" limitation presently in the claims. In fact, like Wohead, the chamber 12 is intended to be removed from the float 10 so that weights 14 can be added or removed to control the buoyancy of the bobber-sinker. Like the disclosure of Wohead, this is a critically important feature of the

invention and disclosure of Witkoski. Accordingly, independent claims 1 and 26 and their respective dependent claims are distinguishable from Witkoski under § 102.

Further, it would not have been obvious to modify Witkoski by non-detachably connecting the weight-receiving chamber 12 from the float 10. If this was done, weights 14 could not be added or removed as is required. This is a critical feature of the disclosure of Witkoski and must be present for the invention of Witkoski to function for its intended purpose. Thus, there is no motivation in Witkoski to make such modification, and such modification would be inconsistent with the teachings of Witkoski and thus not obvious.

Accordingly, for all of the above reasons, the present claims, as amended, are distinguishable from Wohead and Witkoski, both under § 102 and § 103.

The dependent claims which depend from independent claims 1 and 26 include all of the limitations of their respective independent claims and thus are patentable for the same reasons.

The dependent claims add further structural features which further distinguish the present claims from Wohead and Witkoski, both individually and in combination with other references. Specifically, with respect to claim 3, Wohead fails to disclose a tubular members being constructed of metal.

With respect to claims 8 and 19, it would not have been obvious to make the weighted portion of Wohead out of a molded metal, with the noise-generating element being molded into the weighted portion.

With respect claims 9, 20 and 28, it would not have been obvious to provide Wohead an exterior plastic seal coating for a dip coating covering the entirety of the sinker. This would essentially render the device of Wohead non-detachable, which would be totally inconsistent with its disclosure.

With respect to claims 12 and 17, which require a wire extending substantially through the entirety of the body, there is absolutely no motivation to provide Wohead with a wire. Accordingly, it would not have been obvious to do so.

With respect to dependent claims 13, 18, and 21, none of the references discloses first and second weighted portions on opposite sides or ends of the buoyant portion.

Accordingly, in view of the amendments to the claims, the discussion of the references, and the distinctions between the amended claims and such references, it is submitted that the present claims are now in condition for allowance, such action is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Marked-up Version Showing Changes.**"

Respectfully submitted,

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MARKED-UP VERSION SHOWING CHANGES

IN THE CLAIMS

1. (Twice Amended) A fishing sinker comprising:

an elongated body having a line connection end and a free end and having a buoyant section and a weighted section, said weighted section constructed of a weighted material having density greater than that of water and being positioned closer to said free end than said line connection end and

a noise generating element non-detachably connected with said weighted section at said free end so that said weighted section is between said buoyant section and said noise generating element, said noise generating element comprising a hollow member and one or more noise generating objects moveable freely within said hollow member.

26. (Amended) A fishing sinker comprising:

an elongated body having a line connection end and a free end, said body having a weighted section constructed at least in part of a solid weighted material having a density greater than that of water and

a noise generating element non-detachably connected with said elongated body at said free end so that the entirety of said weighted section is between said noise generating element and said line connection end, said noise generating element comprising a hollow member and one or more noise generating objects moveable freely within said hollow member.